

## REMARKS

With the entry of this amendment, claims 33-52 are pending. Non-elected claim 32 and claim 36 are cancelled herein without prejudice. Claims 33 and 37-39 are amended herein. The amendments add no new matter.

### Formalities:

#### Specification:

The specification was previously objected to because the text is not clearly visible on, e.g., pages 10, 12, 20, 22, 30, 32, 34, 42, 44 and 46. The Final Office Action notes that applicants stated that a substitute specification has been provided along with the response to the last Office Action, but that “no copy is available.” The Final Office Action requests that applicants provide a new copy of the substitute specification. Applicants submit that a copy of the substitute specification was filed with the previous response on October 8, 2003, and that receipt of the substitute specification was acknowledged by the Patent Office by return of the postcard listing the substitute specification. A copy of the date-stamped postcard is enclosed. While Applicants submit that the substitute copy was included in the previous response, in the interest of advancing prosecution of the application, a new copy is enclosed herewith. As before, Applicants submit that the substitute specification is identical in content to that originally filed, and that no new matter is added. Applicants note that the substitute specification includes the claims as originally filed (on pages 50-52) before the Abstract on page 53 – Applicants wish to emphasize that the claims to be currently considered are those in the “Listing of the Claims” beginning on page 3 of this response.

#### Priority:

The Office Action acknowledges Applicants’ claim for foreign priority, but notes that a certified copy of UK priority document GB 9722131.1 has not been filed. A certified copy of the priority document is filed herewith.

The Office Action also notes that in order to obtain the benefit of a previously filed application, a specific reference to the earlier filed application must be made in the instant application. The Office Action then continues to explain the requirement for a petition to enter a

late priority claim in applications filed on or after November 29, 2000. Applicants submit that the present application was filed on February 24, 2000, and therefore does not require a petition for entry of the amendment providing the specific reference. Applicants provide herein an amendment to the specification adding specific reference to the priority documents and specifying the nature of their relationship to the present application. The amendment adds no new matter. Entry of the amendment is respectfully requested.

Figures:

The Office Action notes that the application was filed with informal figures and that formal figures will be required when the application is allowed. Formal Figures 1-6 (nine sheets) are submitted herewith. Applicants request their entry to the application.

Rejection under 35 U.S.C. §102(e):

The rejection of claims 33-41 and 44-52 under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 6,057,098 (Buechler et al.) is maintained in the Final Office Action. The Office Action states that both of the Rule 131 Declarations submitted by inventors Tomlinson and Winter are “directed to antibody libraries, whereas the instant independent claim is drawn to selecting peptides from a repertoire of polypeptides (different from the antibody library).” The Office Action notes that the §102(e) rejection of claims 36-52 would be withdrawn upon entry of the priority document “since the claims are drawn to antibody libraries or repertoires.” Applicants respectfully disagree.

Applicants submit that, in order to antedate a reference using a declaration under Rule 131, the Applicants need not demonstrate prior reduction to practice of the full scope of the claimed invention. Rather, Applicants must demonstrate prior invention of that material said to be taught by the cited reference. See, for example, *In re Stempel*, 241 F.2d 755 (CCPA, 1957), in which inventor Stempel filed an application containing both a broad generic claim for chemical compounds (isoprenyl benzenes) and a specific claim to a species encompassed within the generic claim (3,4-dichloro-isoprenyl benzene). The Amos patent disclosed but did not claim the species taught by Stempel (3,4-dichloro-isoprenyl benzene). Stempel submitted a Rule 131 affidavit showing that he had made the species before the effective filing date of the Amos patent. The Patent Office Board of Appeals allowed Stempel’s claim for the species on the basis

of the affidavit, but refused to allow the genus claim because Stempel did not show completion of the genus. The Court of Customs and Patent Appeals reversed the Board, stating:

“What the board is here saying, in effect, is that the invention, the completion of which must be shown by a Rule 131 affidavit, is the invention defined in the claim the applicant is asking for and, if it is a generic claim, prior completion of the generic invention must be shown, whether or not the reference discloses the generic invention.

“We think that is a too literal construction of the rule and not in accord with past practice. {Citations omitted} We are convinced that *under the law all the applicant can be required to show is priority with respect to so much of the claimed invention as the reference happens to show*. When he has done that he has disposed of the reference.” *In re Stempel* at 759 (emphasis added).

Applicants submit that *Stempel* is on point for the present application, in that Buechler et al. teaches only methods involving antibodies, analogous to the Amos patent’s teaching of only the 3,4-dichloro-isoprenyl benzene, while Applicants’ declarations under Rule 131 describe prior invention of an embodiment of the presently claimed invention involving antibodies. Following the reasoning of the court in *Stempel*, Applicants can only be required to show priority with respect to so much of the claimed invention as Buechler et al. allegedly teaches, i.e., a method involving antibodies. Thus, Applicants’ declaration demonstrating prior invention of an embodiment of the claimed methods involving antibodies is sufficient to overcome Buechler et al.

In view of the above, Applicants submit that the Rule 131 declarations of inventors Tomlinson and Winter are sufficient to antedate the Buechler et al. reference.

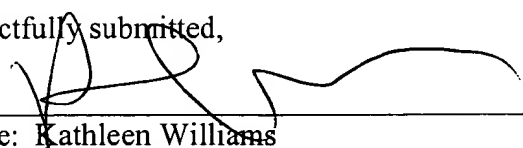
Nonetheless, and solely in the interest of advancing prosecution, Applicants have amended claim 33 herein to recite a “method for selecting a binding polypeptide from a repertoire of immunoglobulin superfamily polypeptides.” The amendment is supported throughout the specification, but particularly at, for example page 12, lines 6-16, and in the claims as filed. In view of the amendment, dependent claim 36 is cancelled, and the dependencies of claims 37-39 are amended to be from claim 33 instead of cancelled claim 36. The amendments add no new matter. Applicants respectfully request the entry of the amendment.

09/511,939

In view of the above, Applicants submit that all issues raised in the Office Action have been addressed herein and that the claims are in condition for allowance. Applicants respectfully request reconsideration of the claims.

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Respectfully submitted,



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